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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/600,317	06/20/2003	Brian J. Cragun	ROC920030231US1	9777
7590 12/16/2005				
William J. McGinnis, Jr. IBM Corporation, Dept. 917 3605 Highway 52 North Rochester, MN 55901-7829		EXAMINER LIN, SHEW FEN		
		ART UNIT PAPER NUMBER 2166		

DATE MAILED: 12/16/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b> 10/600,317	<b>Applicant(s)</b> CRAGUN ET AL.	
	<b>Examiner</b> Shew-Fen Lin	<b>Art Unit</b> 2166	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 20 June 2003.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-26 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-26 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 20 June 2003 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date <u>6/20/03, 4/11/05</u> | 6) <input type="checkbox"/> Other: _____  |

### **Detail Action**

- a. This action is responsive to communications: application filed on 6/20/2003, IDS filed on 6/20/03 and 4/11/05.
- b. Claims 1-26 are pending in this Office Action. Claims 1, 7, 16 and 20 are independent claims.

### **Drawings**

The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description:

“memory 133” in paragraph [0048], lines 3 and 7, paragraph [0049], line 2.

“134” in paragraph [0048], line 4.

“annotation plug-ins 122” in paragraph [0055], line 2.

“an annotation browser 126” in paragraph [0056], line 1.

“the annotation browser 128” in paragraph [00106], line 4.

“Annotations buttons 802 and 804”, in paragraph [00110], line 3.

“pull down menu 812” in paragraph [00113], line 4.

“check boxes 712<sub>B</sub>” in paragraph [00114], line 6.

“text box 714<sub>B</sub>” in paragraph [00114], line 6.

“check boxes 714<sub>C</sub>” in paragraph [00115], line 5.

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Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

### ***Specification***

The disclosure is objected to because of the following informalities: paragraph [0027], lines 1-3. The paragraph is a redundancy of paragraph [0025].

Appropriate correction is required.

### ***Claim Rejections – 35 USC § 101***

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-6 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

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**MPEP 2106 IV. B.2. (b)**

A claim that requires one or more acts to be performed defines a process. However, not all processes are statutory under 35 U.S.C. 101. Schrader, 22 F.3d at 296, 30 USPQ2d at 1460. To be statutory, a claimed computer-related process must either: (A) result in a physical transformation outside the computer for which a practical application in the technological arts is either disclosed in the specification or would have been known to a skilled artisan (discussed in i) below), or (B) be limited to a practical application within the technological arts.

Claims 1-6 in view of the above-cited MPEP section are not statutory because they merely recite steps that can be performed by a person with pen and paper. The use of a computer or a data processor has not been indicated being used to perform the steps. The language of the claim raises a question as to whether the claim is directed merely to an abstract idea that is not tied to a technological art, environment or machine which would result a practical application producing a concrete, useful, and tangible result to form the basis of statutory subject matter under 35 U.S.C. 101 nor is there a transformation of something physical to another state or thing.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(a) the invention was known or used by others in this country, or patented or described in a printed publication in this or a foreign country, before the invention thereof by the applicant for a patent.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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Claims 1-6 and 16-19 are rejected under 35 U.S.C. 102(a) and 102(e) as being anticipated by Bays et al. (US Patent 6,519,603, hereinafter referred as Bays).

**As to claim 1**, Bays discloses a method for deploying an annotation system (Figure 1) in an enterprise comprising:

identifying annotatable data objects (data in a variety of sources and types, column 2, lines 13-21, column 5, lines 31-33);

identifying annotation metadata to be kept for each combination of at least one role and at least one annotatable data object (structure depends on context of the author, context read on role, Figures 3A/B, column 5, lines 26-30); and

creating annotation structures, for each combination of at least one role and at least one annotatable data object, containing fields associated with the identified annotation metadata (Figure 3C, column 3, lines 16-20, column 7, lines 43-50).

**As to claim 2**, Bays discloses wherein identifying annotatable data objects related to the processes comprises:

identifying data sources (Figure 3A, column 8, lines 4-19); and

identifying subtypes of the data sources (column 8, lines 20-26).

**As to claim 3**, Bays discloses wherein at least one identified data source is a database table (column 2, lines 21-28) and at least one identified subtype of the database table is a particular type of database table (relational table or spreadsheet, column 2, lines 21-28).

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**As to claim 4**, Bays discloses wherein at least one identified data source is a text document (column 2, lines 13-15) and at least one identified subtype of the text document is a particular type of text document (column 2, lines 13-15).

**As to claim 5**, Bays discloses further comprising installing the annotation system, accessible by various users within the enterprise, wherein the various users are able to create annotations for data objects based annotation structures associated with the data objects and the roles of the users (annotation structures vary based on the context, i.e. role, of the annotation author, column 8, lines 33-35, column 9, lines 43-45).

**As to claim 6**, Bays discloses wherein the annotation system presents, to the various users, graphical user interface screens for creating annotations for data objects (Figure 4, column 6, lines 34-37, column 10, lines 66-67), wherein the graphical user interface screens allow a user to enter information for annotation fields contained in an annotation structure associated with the data object and the user's role (column 9, lines 43-45).

**As to claim 16**, Bays discloses a computer-readable medium containing an executable component for configuring an annotation system for managing annotations created for data objects manipulated by one or more applications on a network (Figure 1) which, when executed by a processor, performs operations comprising:

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providing at least one graphical user interface screen for defining annotation structures containing one or more annotation fields (Figures 2 and 3B, column 7, lines 15-18, lines 43-50) ;  
and

providing at least one graphical user interface screen for associating annotation structures with at least one annotatable data object (Figure 3B, column 9, lines 43-49).

**As to claim 17**, Bays discloses wherein the operations further comprise providing at least one graphical user interface screen for associating at least one role with at least one user (context reads on role, column 3, lines 10-14, column 9, lines 47-49).

**As to claim 18**, Bays discloses wherein the operations further comprise providing at least one graphical user interface screen for associating at least one transform with an annotation structure, the transform for use in generating a graphical user interface based on the annotation structure (column 3, lines 20-33).

**As to claim 19**, Bays discloses wherein the operations further comprise providing at least one graphical user interface screen for specifying how users of users operating in different roles can access fields contained in an annotation structure (display annotation content based on the context of the reader, column 3, lines 25-33).



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Claims 7-8, 12-21, and 23-26 are rejected under 35 U.S.C. 102(e) as being anticipated by Barger et al. (US Pub 2004/0205545, hereinafter referred as Barger).

**As to claim 7**, Barger discloses a method for exchanging information between entities on a network (exchanging information through annotation, paragraph [0005]) comprising:

installing an annotation management system on the network (Figure 4, paragraph [0037], lines 3-7);

identifying a plurality of annotatable data objects manipulated by a plurality of applications on the network (different content types and applications, paragraph [0021], lines 1-4, paragraph [0024], lines 5-14); and

providing a set of one or more configuration tools allowing a user to define an annotation structure containing one or more annotation fields and associate the annotation structure with at least one of the annotatable data objects (Figure 5, paragraph [0042], [0046], and [0052]).

**As to claim 8**, Barger discloses wherein the configuration tools further allow a user to define roles and associate annotation structures with combinations of roles and annotatable data objects (Set element allows annotation structure to be grouped, paragraph [0056]).

**As to claim 12**, Barger discloses wherein the configuration tools: allow a users to specify one or more annotation field groups (composite or sets, Figures 6 and 7, paragraph [0052], lines 1-3, paragraph [0056], lines 1-3); and allow annotation field groups to be added to annotation structures (paragraph [0051]).

**As to claim 13**, Barger on discloses wherein the configuration tools allow a user to associate one or more transforms with an annotation structure, the transforms for use in converting the annotation structure into a graphical user interface (convert annotation structure to corresponding type of annotation, text, multimedia, Figures 2-3).

**As to claim 14**, Barger on discloses wherein the configuration tools allow a user to associate an annotation structure with annotatable data objects associated with more than one data source (each annotation can include multiple context anchors, paragraph [0030], lines 6-17).

**As to claim 15**, Barger on discloses wherein the configuration tools allows annotatable sub-objects of data objects to be associated with annotation structures (define relationship between content being annotated and the content that is annotating, Figure 1, paragraph [0025])

**As to claim 20**, Barger on a system for managing annotations for one or more different type data sources manipulated by a plurality of different type applications (paragraph [0021], lines 1-4), comprising:

an annotation database for storing annotations separately from the data sources associated with the annotations (annotation store, SQL database, Figure 4, item 140, paragraph [0039], lines 1-8);

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a set of annotatable data object points defining portions of the data sources associated with the annotations described by the associated annotations (Figure 1, paragraph [0027], lines 1-10, paragraph [0056]);

an annotation server configured to receive requests to access annotations for one or more of the annotatable data object points issued by the one or more of the applications running on the client computer and generate a graphical user interface screen ( create/view/edit/delete annotation, Figures 10-13, paragraph [0037], lines 8-19), based on an annotation structure associated with the one or more of the annotatable data object points, for creating or viewing annotations for the one or more annotatable data object points (paragraph [0049], lines 4-14); and

one or more configuration tools allowing a user to define annotation structures and associate annotation structures with one or more of the annotatable data object points (Figures 5-7, paragraph [0042], paragraph [0046])

**As to claim 21**, Barger on discloses wherein the configuration tools allow users to associate a single annotation structure with annotatable data object points associated with more than one data source (paragraph [0030], lines 4-7, paragraph [0051], paragraph [0056]).

**As to claim 23**, Barger on discloses wherein the configuration tools allow users to associate one or more annotation structures with at least one of:

one or more combinations of annotatable data object points and roles; or

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one or more combinations of annotatable data object points and users (define relationship between content being annotated and the content that is annotating, Figure 1, paragraph [0025], paragraph [0056]).

**As to claim 24**, Barger on discloses wherein the configuration tools allow users to associate one or more transforms with one or more annotation structures, each transform for use in generating a graphical user interface based on an associated annotation structure (convert annotation structure to corresponding type of annotation, text, multimedia, Figures 2-3).

**As to claim 25**, Barger on discloses further comprising a plurality of configuration files and wherein the configure tools allow a user to navigate and modify one or more of the configuration files (paragraph [0059] and [0075]).

**As to claim 26**, Barger on discloses wherein the configuration files are extensible markup language (XML) files (paragraph [0059]).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claims 9 –11, and 22 are rejected under 35 U.S.C. 103(a) as being obvious over Bargerion as applied to claim 7 above, and further in view of Tada et al. (US Patent 6,490,583, hereinafter referred as Tada).

**As to claim 9**, Bargerion discloses the elements of claims 7 as noted above and group annotations together for access control (paragraph [0056], lines 1-3) but does not explicitly

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discloses provide one or more graphical user interface screens for associating one or more roles with a user.

Tada discloses associating one or more group (roles) with a user (Figures 2-3, column 4, lines 1-8, column 5, lines 63-64).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Bargerion's disclosure to include associating user to one or more groups (roles) as taught by Tada for the purpose of allowing user to access the information for each group to which the users belong (column 2, lines 32-34, Tada). The skilled artisan would have been motivated to improve the invention of Bargerion per the above such that access control to group level is easy to carry out (column 1, lines 59-65, Tada).

**As to claim 10**, Bargerion discloses the elements of claims 7 as noted above and group annotations together for access control (paragraph [0056], lines 1-3) but does not explicitly discloses provide one or more graphical user interface screens for associating one or more users with a role.

Tada discloses associating one or more users with a group (role) (Figures 2-3, column 4, lines 1-8).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Bargerion's disclosure to include associating user to one or more groups (roles) as taught by Tada for the purpose of allowing user to access the information for each group to which the users belong (column 2, lines 32-34, Tada). The skilled artisan would have

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been motivated to improve the invention of Barger on per the above such that access control to group level is easy to carry out (column 1, lines 59-65, Tada).

**As to claim 11**, Barger on discloses the elements of claims 7 as noted above and group annotations together for access control (paragraph [0056], lines 1-3) but does not explicitly discloses specify one or more filters specifying how annotation fields contained in an annotation structure can be manipulated based on user roles.

Tada discloses depending on the groups (roles) the users belonging to, users can only access the documentations (reads on annotation), which are accessible for the groups based on access control determination (Figure 8, column 6, lines 23-26, column 7, lines 55-64).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Barger on's disclosure to include associating documentation (annotation) to one or more groups (roles) as taught by Tada for the purpose of allowing user to access the information after filtering with access control (column 2, lines 64-65, Tada). The skilled artisan would have been motivated to improve the invention of Barger on per the above such that access control can be conducted based on the groups (roles) to which users belong (column 2, lines 47-50, Tada).

**As to claim 22**, Barger on discloses the elements of claims 20 as noted above and group annotations together for access control (paragraph [0056], lines 1-3) but does not explicitly discloses allow users to associate one or more roles with one or more users.

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Tada discloses associating one or more group (roles) with one or more users (Figures 2-3, column 4, lines 1-8, column 5, lines 44-47, lines 63-64).

It would have been obvious to a person of ordinary skill in the art at the time of invention was made to modify Bargerion's disclosure to include associating one or more groups (roles) to one or more users as taught by Tada for the purpose of allowing user to access the information for each group to which the users belong (column 2, lines 32-34, Tada). The skilled artisan would have been motivated to improve the invention of Bargerion per the above such that access control to group level is easy to carry out (column 1, lines 59-65, Tada).

#### ***Related Prior Arts***

The following list of prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

- Eintracht et al., US 6,687,878 B1, "Synchronizing/updating local client notes with annotations previously made by other clients in a notes database", (...documents and associated annotations are treated independently from each other. Separate data structures are created for the documents and for the associated annotations).
- Evans, William D., US 20020099947 A1, "Secure content objects", (...controlling access to ancillary information, such as annotations, associated with electronic documents)



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***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Shew-Fen Lin whose telephone number is 571-272-2672. The examiner can normally be reached on 8:30AM - 5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hosain Alam can be reached on 571-272-3978. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Shew-Fen Lin  
Patent Examiner  
Art Unit 2166  
December 7, 2005

  
**MOHAMMAD ALI**  
**PRIMARY EXAMINER**